

REMARKS

Applicants request favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Of claims 1-10 that were pending in the application, claims 1-3 and 6-10 were rejected in the Office Action. Applicants appreciate the allowance of claims 4 and 5. By way of this amendment, Applicants have: (a) made a clerical correction to the preamble of claim 10; and (b) added new claims 11-18, which depend from allowed claim 4. New claims 11-18 recite limitations that are also recited in claims 1-3 and 6-10 and, therefore, claims 11-18 do not present new matter. Claims 1-18 are respectfully presented for further consideration.

Claims 1-3 and 6-10 stand rejected under 35 U.S.C. §§ 102(e), 103(a) as allegedly being anticipated by, or obvious in view of, U.S. Patent No. 6,290,159 (“Specht”). For at least the following reasons, Applicants respectfully traverse these rejections.

The Examiner contends that “it is deemed inherent that the motor is variable in torque/speed which is usually effected by a variable resistor such as a rheostat in series with the motor.” (Office Action at p. 2). To establish inherency, the extrinsic evidence must make clear that the variable resistor is necessarily present in the Specht retractor, and that it would be so recognized by a person of ordinary skill in the art. In re Robertson, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). As there are several ways to provide a variable current, it is clear that a variable resistor is not “necessarily present” in the Specht retractor. Thus, there is no basis for a rejection under 35 U.S.C. § 102(e).

There is also no basis for a rejection under the alternative grounds of 35 U.S.C. § 103. Specifically, in response to Applicants’ previous remarks regarding Specht’s failure to disclose, teach, or suggest a variable resistor that is in series with a motor, the Examiner asserts: “the provision of rheostat in series with the motor to variably control the motor would have been obvious to a person having ordinary skill in the art as such is old and well known and Official notice of such is hereby taken.” The Examiner’s application of Official Notice, however, fails to satisfy the requirements set forth in M.P.E.P. §§ 2144.03(A), (B).

As stated in the M.P.E.P.: “assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by a citation to some reference work recognized as standard in the pertinent art.” M.P.E.P. § 2144.03(A) (citing *In re Ahlert*, 424 F.3d at 1091, 165 U.S.P.Q. at 420-21 (C.C.P.A. 1970)) (underline emphasis added). Moreover, “It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record.” *See id.* (citing *In re Zurko*, 258 F.3d at 1385, 59 U.S.P.Q.2d at 1697 (Fed. Cir. 2001)) (underline emphasis added). Counter to both

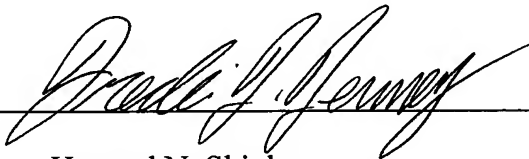
of § 2144.03(A)'s explicit prohibitions on the application of Official Notice in this instance, the Examiner has done so. Moreover, the Examiner has failed to support his statement that using variable resistors is "old and well known," and, therefore, the rejection is also improper under § 2144.03(B). Finally, even assuming, *arguendo*, that variable resistors were well known to those of ordinary skill in the art, there has been no evidentiary showing that those of ordinary skill would have been motivated to use such variable resistors in series with a motor, as recited in claim 1.

In light of all and at least the foregoing reasons, Applicants respectfully request a withdrawal of the rejection of claims 1-3 and 6-10 under §§ 102(e), 103(a). Moreover, should the Examiner wish to uphold this rejection based on a proper application of Official Notice, Applicants respectfully request that the Examiner support the rejection using documentary evidence, as is Applicants' right under M.P.E.P. § 2144.03(C).

For the aforementioned reasons, claims 1-18 are now in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

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THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED REGARDING THIS APPLICATION UNDER 37 C.F.R. §§ 1.16-1.17, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 19-0741. SHOULD NO PROPER PAYMENT BE ENCLOSED HERewith, AS BY A CHECK BEING IN THE WRONG AMOUNT, UNSIGNED, POST-DATED, OTHERWISE IMPROPER OR INFORMAL OR EVEN ENTIRELY MISSING, THE COMMISSIONER IS AUTHORIZED TO CHARGE THE UNPAID AMOUNT TO DEPOSIT ACCOUNT NO. 19-0741. IF ANY EXTENSIONS OF TIME ARE NEEDED FOR TIMELY ACCEPTANCE OF PAPERS SUBMITTED HERewith, APPLICANT HEREBY PETITIONS FOR SUCH EXTENSION UNDER 37 C.F.R. § 1.136 AND AUTHORIZES PAYMENT OF ANY SUCH EXTENSIONS FEES TO DEPOSIT ACCOUNT NO. 19-0741.